

REMARKS

In the Office action, it was indicated that in view of the Appeal Brief filed on March 27, 2009 prosecution of the instant application was reopened based on a new ground of rejection. Pending claims 11-18 are allowed. Pending claims 19-27 stand rejected. It was further indicated that a response to the non-final Office action may be filed or a new appeal may be initiated. Applicant has elected at this time to file this amendment in reply to the Office action.

Previously submitted claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Apps et al. (U.S. Patent No. 6,006,677) in view of the publications entitled "Fire and Polyvinyl Chloride" ("the Vinyl Institute reference") and "The Synthesis and Characterization of New Thermoplastic Fire Resistant Materials" ("the McGrath reference"). Claim 19 has also been rejected under 35 U.S.C. § 102(b) as being anticipated by Apps et al. despite the fact that the heading for that section only identifies a rejection under 35 U.S.C. § 103(a).

The examiner cites Apps et al. as teaching structure including a pallet assembly and fire resistant layer formed upon an exterior of a pallet assembly. The examiner further maintains that plastics including thermoplastic material provide a fire resistant layer as claimed since thermoplastic material is inherently fire resistant, for example fire resistant compared to wood or paper.

Similarly, claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gronnevik (U.S. Patent No. 5,845,588) or Gronnevik in view of the Vinyl Institute reference and the McGrath reference and, apparently, under 35 U.S.C. § 102(b) as being anticipated by Gronnevik.

Also, previously submitted claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gronnevik. Previously submitted claims 20, 21, and 23-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gronnevik in view of Ford et al. (U.S. Patent No. 6,228,914).

In response to the rejections, new claims 28-37 have been added by amendment. The amendment does not add new matter.

Regarding the rejection to claim 19 in view of Apps et al. or in view of Apps et al. in combination with the Vinyl Institute reference and the McGrath reference, Apps et al. has been reviewed and, as understood, discloses a plastic pallet having an anti-slip layer that is provided by scuffing the outer surface. Apps et al. does not disclose or suggest a fire resistant layer. See also Muirhead Dec. ¶¶ 5-6.

Applicant respectfully requests that the examiner identify specifically in the Apps et al. reference the teaching of "a fire resistant layer formed upon an exterior of the pallet assembly." Is the examiner suggesting that because Apps et al. discloses a plastic pallet assembly and the examiner believes that thermoplastic material is inherently fire resistant, then Apps et al. teaches a fire resistant layer formed upon an exterior of the

pallet assembly? If so, then such reasoning is improper for a rejection of claim 19 under both 35 U.S.C § 102(b) and 35 U.S.C § 103(a). Reconsideration and withdrawal of the rejection of claim 19 is respectfully suggested.

The "anti-slip" layer that is disclosed in Apps et al. is made from the same material as the bulk material. Accordingly, Apps et al. does not disclose or suggest a "fire resistant layer", so that the examiner must rely upon the McGrath reference and the Vinyl Institute reference to provide this element.

Regarding the anticipation rejection under 35 U.S.C. § 102(b), Applicant submits that the rejection necessarily relies upon the inherency doctrine since Apps et al. expressly teaches an "anti-slip" layer, as opposed to a fire resistant layer. The purported reasoning for the inherency rejection is the assertion that "plastics including thermoplastic material is inherently fire resistant." Office Action at 3. The Board of Patent Appeals and Interferences set forth a standard for evaluating an examiner's assertion of the inherency doctrine, as follows:

[i]n relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The evidence of record, specifically the Vinyl Institute reference and the McGrath reference, does not meet this standard.

The Coleman Declaration demonstrates that the two references cited by the examiner in support of the assertion do not state

what the examiner asserts they state. See Coleman Dec. ¶¶ 12-19.¹

Indeed, the Coleman Declaration demonstrates that at least one of the references, the McGrath reference, directly contradicts the examiner's position. Coleman Dec. ¶ 14. This contradiction establishes that thermoplastic materials are not necessarily fire resistant materials.

In addition, the Coleman Declaration indicates that the examiner is not using the proper terminology in describing the content of the references. The Coleman Declaration indicates that the McGrath reference refers to "fire safe" polymers, not "fire resistant" plastics, and that the term "fire safe" has a very specific definition to a person of ordinary skill in the art. See Coleman Dec. ¶ 15.

The Coleman Declaration also indicates that the Vinyl Institute reference is of limited value because it relies upon ASTM standards, which include the following disclaimer:

"This standard should be used to measure and describe the fire response of materials, products, or assemblies to heat and flame under controlled laboratory conditions and should not be used to describe or appraise the fire-hazard or fire risk of materials, products, or assemblies under actual fire conditions. However, results of this test may be used as elements of a fire-hazard assessment or a fire risk assessment which takes into account all of the factors which are pertinent to an assessment of the fire hazard or fire-risk of a particular end use."

Coleman Dec. ¶ 18 (citing Annual Book of ASTM Standards 2006, Vol. 8.01, D 2843 p. 714 ¶ 1.4). Accordingly, the inherency doctrine cannot be applied in the instant case because the existence of a

¹ The Muirhead Declaration also addresses the examiner's rejection

"fire resistant layer" does not necessarily flow from the teachings of the cited prior art.

Regarding the rejection under 35 U.S.C. § 103(a) in view of Apps et al., Applicant submits that Apps et al., alone or in combination with the Vinyl Institute reference or the McGrath reference, does not teach or suggest all of the elements of claim 19 because Apps et al. does not teach or suggest a fire resistant layer for the reasons set forth above.

Applicant also notes that the Coleman Declaration identifies the following deficiencies in the above-identified cited references that establish that the references do not render claim 19 obvious:

- "The [McGrath reference] includes no disclosure or suggestion that all plastics provide fire resistance." [Coleman Dec. ¶ 13].
- "Indeed, the McGrath reference states that the two engineering resins 'are considered candidates for fire safe thermoplastic materials.'" [Coleman Dec. ¶ 14].
- "The term 'fire safe' is used in the industry to denote a class of polymers that can meet the more demanding application areas of plastics. This includes commercial aircraft where approximately two or three minutes are allowed to evacuate a distressed airplane before the fire hazard from all sources is considered too great to survive. The plastic that is currently used for aircraft interiors is expensive (over \$ 20 per pound) and 'fire safe' cost effective replacements have been an important target for those doing plastics research for many years. Professor McGrath has been working in this area for many years as have others. So far no 'fire safe' candidates have replaced the existing plastic, so the search continues for a truly 'fire safe' plastic." [Coleman Dec. ¶ 15].
- "The Vinyl Institute reference does not state that plastics, in general, inherently provide fire resistance." [Coleman Dec. ¶ 16].

of claim 19. See Muirhead Dec. ¶¶ 7-11.

For these reasons, Applicant respectfully requests that the obviousness rejection of claim 19 with respect to Apps et al. in combination with the Vinyl Institute reference and the McGrath reference be withdrawn as failing to meet the factual inquiries for a determination of obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

Moreover, common sense dictates that all plastics are not inherently fire resistant. On June 19, 2008, two patent applications were published that expressly stated:

[f]urthermore, the problem arises in the case of plastic pallets that plastic is flammable such that, in the event of fire, toxic gases can develop.

U.S. Patent Publication No. 2008/0141912 A1 ¶ 3; U.S. Patent Publication No. 2008/0143514 A1 ¶ 3. Accordingly, the examiner's assertion that plastics are inherently fire resistant is baseless.

In addition, common sense dictates that the anti-slip "layer" in Apps et al. should have the same flammability properties as the bulk material because the anti-slip "layer" is made from the same material. Accordingly, Apps et al. does not render claim 19 unpatentable because it does not teach or suggest a fire resistant layer.

Regarding the rejection to claim 19 in view of Gronnevik or in view of Gronnevik in combination with the Vinyl Institute reference and the McGrath reference, Gronnevik has been reviewed and, as understood, discloses a multi-layer structure in which a polyolefin material is coated with an anti-slip layer of EVA or EBA. See Column 5, lines 54-55. Gronnevik does not disclose or

suggest a fire resistant layer. Accordingly, Gronnevik does not disclose or suggest a "fire resistant layer", so that the examiner must rely upon the McGrath reference and the Vinyl Institute reference to provide this element.

Regarding the anticipation rejection of claim 19 under 35 U.S.C. § 102(b), it is clear that the Gronnevik reference does not anticipate claim 19 because it does not teach all of the elements of claim 19. Accordingly, the examiner must rely upon the teachings of the Vinyl Institute reference and the McGrath reference as the purported basis for application of the inherency doctrine.

However, as set forth above, the Coleman Declaration (and the Muirhead Declaration) demonstrate that the two references cited by the examiner do not state what the examiner asserts they state for the reasons set forth above.). Accordingly, the inherency doctrine cannot be applied in the instant case because the existence of a "fire resistant layer" does not necessarily flow from the teachings of the cited prior art.

Regarding the rejection of claim 19 under 35 U.S.C. § 103(a) in view of Gronnevik, Applicant submits that Gronnevik, alone or in combination with the Vinyl Institute reference and the McGrath reference, does not teach or suggest all of the elements of claim 19 because Gronnevik does not teach or suggest a fire resistant layer for the reasons set forth above.

Indeed, the Coleman Declaration identifies a key deficiency in Gronnevik, as follows:

"The Gronnevik patent discloses a multi-layer structure, but does not disclose a multi-layer structure in which a fire resistant layer covers a polyolefin base material." [Coleman Dec. ¶ 21].

For these reasons, Applicant respectfully requests that the obviousness rejection to claim 19 in view of Gronnevik, alone or in combination, be withdrawn.

Moreover, Applicant notes that the Coleman Declaration identifies the following deficiencies in the Vinyl Institute reference and the McGrath references that were discussed above. Specifically, the Coleman Declaration states:

- "The [McGrath reference] includes no disclosure or suggestion that all plastics provide fire resistance." [Coleman Dec. ¶ 13].
- "Indeed, the McGrath reference states that the two engineering resins 'are considered candidates for fire safe thermoplastic materials.'" [Coleman Dec. ¶ 14].
- "The term 'fire safe' is used in the industry to denote a class of polymers that can meet the more demanding application areas of plastics. This includes commercial aircraft where approximately two or three minutes are allowed to evacuate a distressed airplane before the fire hazard from all sources is considered too great to survive. The plastic that is currently used for aircraft interiors is expensive (over \$ 20 per pound) and 'fire safe' cost effective replacements have been an important target for those doing plastics research for many years. Professor McGrath has been working in this area for many years as have others. So far no 'fire safe' candidates have replaced the existing plastic, so the search continues for a truly 'fire safe' plastic." [Coleman Dec. ¶ 15].
- "The Vinyl Institute reference does not state that plastics, in general, inherently provide fire resistance." [Coleman Dec. ¶ 16].

Moreover, common sense dictates that all plastics are not inherently fire resistant. On June 19, 2008, two patent applications were published that expressly stated:

[f]urthermore, the problem arises in the case of plastic pallets that plastic is flammable such that, in the event of fire, toxic gases can develop.

U.S. Patent Publication No. 2008/0141912 A1 ¶ 3; U.S. Patent Publication No. 2008/0143514 A1 ¶ 3. Accordingly, the examiner's assertion that plastics are inherently fire resistant is baseless.

Regarding the rejections of claim 22 under 35 U.S.C. § 103(a), Applicant submits that Gronnevik does not teach or suggest all of the limitations of claim 22 because Gronnevik does not teach or suggest a fire resistant layer formed on the outer surface of a pallet. Accordingly, withdrawal of the rejection of claim 22 for obviousness over Gronnevik for the reasons set forth above is respectfully requested.

Regarding the rejection of claims 20-21 and 23-27 over Gronnevik in view of Ford et al. 35 U.S.C. § 103(a), Ford et al. has been reviewed and, as understood, discloses an aqueous intumescent composition that is applied by conventional coating methods, such as spraying, dipping, drawing, and brushing. See Ford et al., col. 12, lines 1-8. Ford et al. does not teach or suggest that the disclosed intumescent composition can be co-extruded with a polyolefin base material, as defined by the above rejected claims.

Indeed, the Coleman Declaration indicates that Gronnevik cannot be combined with Ford et al. because Ford et al.:

discloses an aqueous intumescent composition, which is not suitable for melt processing in a co-extrusion process. As a result, a person of ordinary skill in the art is unlikely to combine the Gronnevik patent with the Ford patent to produce a polyolefin patent having an intumescent layer through a co-extrusion

process. The Ford coating is not formulated for compatibility with polymer melts; it is a coating that is formulated to bond to rough surface materials as described in the examples. The coating is applied to an existing surface. This Ford coating is a thermoset polymer that cannot be melt processed once it is heated to the curing temperature. Thus, it is totally unsuitable for extrusion or co-extrusion.

Coleman Dec. ¶ 24. Accordingly, Gronnevik and Ford et al. cannot be combined to render claims 20-21 and 23-27 obvious. See also Muirhead Dec. ¶¶ 12-13.

Applicant further submits that claim 22 includes the limitations of claim 20, so that the above reasoning with respect to claims 20-21 and 23-27 applies to claim 22, as well.

Applicant also notes that claim 19 of the instant application interferes with claim 14 of U.S. Patent No. 6,758,148 by Torrey et al. The relevant statute indicates that a claim that is directed to the same or substantially the same subject matter of a claim in an issued patent may not be made more than one year after the issuance of that patent. 35 U.S.C. § 135(b)(1). Accordingly, an interference must be declared between claim 19 of the instant application and claim 14 of Torrey et al. for the reasons set forth in Applicant's December 1, 2006 Office action.

Regarding the newly added claims, independent claim 28 defines a pallet assembly having a molded polyolefin interior structure for supporting a load thereon. An exterior surface is defined as including a fire resistant material having superior fire resistance relative to the molded polyolefin interior structure. This feature is not taught or suggested in any of the

purported prior art references discussed above. New claims 29-33 depend from claim 28, so that they also include the features of claim 28.

New independent claim 34 defines a pallet assembly having:

said pallet member having an inner layer with moldable polyolefin material and an outer layer with a mixture of moldable polyolefin material and intumescent material forming a fire resistant exterior surface thereon.

This feature is not taught or suggested in any of the purported prior art references that are discussed above. New claims 35-36 depend from claim 34, so that they also include the features of claim 34.

Further, in regard to claim 36, the combination of Gronnevik and Ford et al. does not teach or suggest claim 36. The intumescent compound disclosed in Ford et al. cannot be recycled because it is made from an aqueous coating that forms "a thermoset polymer that cannot be melt processed once it is heated to the curing temperature." Coleman Dec. ¶ 24.

New independent claim 37 has been copied from claim 1 of U.S. Patent application Serial No. 10/890,351 ("the '351 application"). Claim 1 of the '351 application was amended on June 13, 2006 and allowed on October 3, 2006. The '351 application was expressly abandoned on November 3, 2006.

The addition of claim 37 is permissible, notwithstanding 35 U.S.C. § 135(b)(2), because the instant application has an earlier effective filing date than the '351 application. See

Ding et al. v. Singer et al., Interference No. 105,436 (BAPI August 24, 2007) at 13.

The rejections of claims 19-27 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) based upon the above discussed prior art references have been traversed. For this reason, it is submitted that all pending claims 11-37, including the newly submitted claims, are in condition for allowance. Accordingly, in view of the above amendments, explanations, and remarks, reconsideration and allowance of claims 19-37, as amended, in addition to the previously allowed claims 11-18, is respectfully requested.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

August 3, 2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

**MING ZHONG DING, KIAN KEONG OOI, YANG QUAN CHEN,
JACK MING TENG, SHUANG QUAN MIN, and BENG WEE QUAK**

**Junior Party
(U.S. Patent 6,704,159)**

v.

NEIL SINGER, MARK TANQUARY, and KENNETH PASCH

**Senior Party
(Application 10/267,332)**

**Patent Interference No. 105,436
(Technology Center 2600)**

**Before JAMESON LEE, SALLY C. MEDLEY, and JAMES T. MOORE,
*Administrative Patent Judges.***

LEE, *Administrative Patent Judge.*

Decision -- Motions -- Bd. Rule 125(a)

1 Party Ding has filed Motions 1 and 2. Party Singer has filed Motion 1. We
2 have jurisdiction to decide these motions under 35 U.S.C. § 135(a).

3 A. Background Facts (Referenced as BF. ¶ No.)

4 1. This interference was declared on April 17, 2007.

5 2. Junior party Ding is involved on the basis of its Patent No. 6,704,159,
6 based on Application 09/810,337, filed March 16, 2001.

7 3. Senior party Singer is involved on the basis of its Application
8 10/267,332, filed October 9, 2002.

9 4. Junior party Ding's real party in interest is Seagate Technology LLC.

10 5. Senior party Singer's real party in interest is Convolv, Inc.

11 6. At the time of declaration of this interference, junior party Ding was
12 accorded benefit of the filing date of Application 60/212,546, filed June 20, 2000.

13 7. At the time of declaration of this interference, senior party Singer was
14 accorded benefit of the filing dates of Application 09/873,464, filed June 4, 2001;
15 Application 09/262,781, filed March 4, 1999; Application 60/109,145, filed
16 November 20, 1998; and Application 60/077,292, filed March 5, 1998.

17 8. The count of this interference is Ding's patent claim 14 or Singer's
18 application claim 28.

19 9 Claim 14 of the Ding patent and claim 28 of the Singer application
20 read identically as follows:

21 A method of operating an apparatus comprising steps of:

22
23 (a) receiving an acoustic adjusting factor, the apparatus being
24 adapted to receive the acoustic adjusting factor externally;
25

1 (b) modifying at least one control parameter for only an
2 actuator of the apparatus responsive to the acoustic adjusting factor;
3 and
4

5 (c) controlling the actuator using the at least one modified control
6 parameter.
7

8 10. At the time of declaration of this interference, Ding's patent claims 1
9 and 14 and Singer's application claims 27 and 28 were the only claims designated
10 as corresponding to the count.

11 11. Claim 1 of Ding's patent and claim 27 of the Singer application read
12 the same as each other.

13 12. The application from which Ding's involved patent issued led to
14 Published Application U.S. 2002/0006010, published on January 17, 2002, of
15 which claim 1 is identical to claim 1 of Ding's involved patent and claim 27 of
16 Singer's involved application.

17 13. Singer's involved application was filed on October 9, 2002, and
18 Singer's claims 27 and 28 were introduced into that application by amendment on
19 September 21, 2004.

20 14. Oral hearing was held in this case on March 27, 2007.

21 B Analysis

22 Ding's Motion 1

23 By Motion 1, party Ding asserts that both Singer's claims corresponding to
24 the count of this interference, claims 27 and 28, are unpatentable under 35 U.S.C. §
25 112, first paragraph, for lack of written description. For reasons discussed below,
26 the motion is without merit.

27 Singer's claims 27 and 28 read as follows:

1 27. A method of operating a disc drive for improved acoustic
2 management, comprising steps of:

3
4 (a) receiving an acoustic/performance comprising¹ factor
5 from a host;

6
7 (b) tuning performance of a disc drive according to the
8 compromising factor, the step of tuning including applying the
9 compromising factor to at least one control parameter for the disc
10 drive to generate at least one modified control parameter; and

11
12 (c) executing a control loop for controlling an operation of
13 the disc drive, the control loop using the at least one modified control
14 parameter.

15
16 28. A method of operating an apparatus comprising steps of:

17
18 (a) receiving an acoustic adjusting factor, the apparatus being
19 adapted to receive the acoustic adjusting factor externally;

20
21 (b) modifying at least one control parameter for only an
22 actuator of the apparatus responsive to the acoustic adjusting factor;
23 and

24
25 (c) controlling the actuator using the at least one modified
26 control parameter.

27
28 A moving party has the burden of proof to establish that it is entitled to the
29 relief requested. 37 CFR § 41.121(b). Applying the appropriate rule for claim
30 interpretation is a prerequisite for party Ding to prevail on its assertion that
31 Singer's claims 27 and 28 are unpatentable under 35 U.S.C. § 112, first paragraph,
32 for lack of written description. If party Ding has not properly determined what are

¹ It appears that the parties have assumed that the claim recites "acoustic/performance compromising factor" . . . rather than "acoustic/performance comprising factor." We will do the same. Party Singer may make an appropriate correction if it prevails and when jurisdiction over its application has returned to the Primary Examiner.

1 required by Singer's claims, then it cannot have established entitlement to the
2 requested relief. That is the case here.

3
4 Expressly provided in 37 CFR § 41.200(b) (2005) is the following:

5 A claim shall be given its broadest reasonable construction **in**
6 **light of the specification of the application or patent in which it**
7 **appears.** (Emphasis added)

8
9 The predecessor rule to 37 CFR § 41.200(b), i.e., 37 CFR § 1.633(a) (1995-2004),
10 also states the same, regarding the basis of claim interpretation:

11 In deciding an issue raised in a motion filed under this paragraph (a), a
12 claim will be construed **in light of the specification of the**
13 **application or patent in which it appears.** (Emphasis added)

14
15 When the predecessor rule was promulgated in 1995, there was a notice in
16 the Federal Register making clear that under the rule it was improper to interpret a
17 party's claim in light of another party's specification, even where the claim was
18 copied from the other party. Specifically, it was stated, 60 Fed. Reg. 14488, 14506
19 (March 17, 1995):

20 As proposed in the Notice of Proposed Rulemaking,
21 paragraph(a) of § 1.633 is revised in several respects. The first is to
22 specify that a claim shall be construed in light of the specification of
23 the application or patent in which it appears. The amendment clarifies
24 an ambiguity in PTO interference practice. Previously, the Federal
25 Circuit had interpreted § 1.633 to require an ambiguous claim to be
26 interpreted in light of the patent from which it was copied. In re
27 Spina, 975 F.2d 854, 856, 24 USPQ2d 1142, 1144 (Fed. Cir. 1992).
28 While this interpretation was a possible interpretation of previous §
29 1.633, PTO had intended that a copied claim be interpreted in light of
30 the specification of the application or patent in which it appears. The
31 rule, as adopted, will make ex parte and inter partes practice the same.
32 A claim that has been added to a pending application for any purpose,

1 including to provoke an interference, will be given the broadest
2 reasonable interpretation consistent with the disclosure of the
3 application to which it is added, as are claims which are added during
4 ex parte prosecution.

5
6 In Rowe v. Dror, 112 F.3d 473, 479 n.2, 42 USPQ2d 1550, 1554 n.2 (Fed. Cir.
7 1997), the Court of Appeals for the Federal Circuit explained that the U.S. Patent
8 and Trademark Office had ample authority to promulgate such a rule and allowed
9 to stand a plain application of the rule.

10 According to party Ding, both the term “acoustic/performance
11 compromising factor” in Singer’s claim 27 and the term “acoustic adjusting factor”
12 in Singer’s claim 28 are used in the specification of Ding’s patent and that in the
13 context of Ding’s patent specification those terms should be narrowly construed
14 such that (1) they mean the same thing despite the apparent difference in wording;
15 and (2) they both mean a single numerical value (Motion 1, page 6, line 26 to page
16 7, line 3). Party Ding’s position is that in light of that narrow construction of the
17 claim terms in light of Ding’s specification, Singer’s claims are without written
18 description in Singer’s specification.

19 Also according to party Ding, the term “control parameter” in Singer’s
20 claims 27 and 28 is used in the specification of Ding’s patent and that in the
21 context of Ding’s patent specification (Motion 1, page 5, ll. 4-8):

22 A control parameter is a parameter calculated independently of
23 execution of the disk drive’s control loop, and defines how the control
24 loop acts on inputs received into the control loop. SOF 34. Control
25 parameters are not calculated based on or using the inputs to the
26 control loop, and are not calculated as part of or during the execution
27 of the control loop, but rather are preset prior to execution of the
28 control loop. SOF 17, 35.

1 It is further asserted that based on Ding's specification, the desired seek
2 velocity is not a control parameter (Motion 1, page 5, line 11; page 8, line 16).
3 Party Ding's position is that in light of the specific meaning of "control parameter"
4 provided in Ding's specification, Singer's claims are without written description in
5 Singer's specification insofar as the modifying a control parameter limitation is
6 concerned.

7 Despite a direct regulation to the contrary, party Ding in its Motion 1
8 interprets Singer's claims 27 and 28 in light of not Singer's specification in which
9 Singer's claims appear, but in light of Ding's specification. The motion does not
10 cite to or acknowledge 37 CFR § 41.200(b), nor predecessor rule 37 CFR
11 1.633(a). Ding does not acknowledge the existence of a contrary rule until its
12 reply, and even then Ding offers no reason why the provision of 37 CFR §
13 41.200(b) should be deemed invalid. Instead, Ding cites to In re Spina, 975 F.2d
14 854, 858, 24 USPQ2d 1142 (Fed. Cir. 1992), the application of which was
15 rendered ineffective by the rule change in 1995 as noted above. In any event, even
16 if we travel back to pre-1995 and attempt to apply In re Spina to this interference,
17 Ding has not shown that Singer's claims 27 and 28 are ambiguous on their face
18 such that we must resort to interpretation in light of the specification of the patent
19 from which those claims were copied. Under In re Spina, *supra*, and even
20 assuming that it still has application today, it is only when the terms of a copied
21 claim are ambiguous that an interpretation would be made based on the
22 specification of the patent from which the claim was copied. Party Ding skipped
23 the threshold ambiguity analysis and proceeded directly to interpreting Singer's
24 claims in light of Ding's specification.

25 Because party Ding interprets Singer's claims 27 and 28 in light of Ding's

1 specification, and not Singer's specification, to support the assertion that Singer's
2 claims 27 and 28 are unpatentable under 35 U.S.C. § 112, first paragraph, for lack
3 of written description, the motion is without merit. It has not been shown that
4 Singer's claims 27 and 28, when construed in light of Singer's own specification,
5 would also have the narrow meanings for claim terms as party Ding would have
6 them construed in light of Ding's specification. For instance, in light of Singer's
7 own specification, "acoustic/performance compromising factor" may not mean the
8 same as "acoustic adjusting factor" and neither may be so narrow as to mean a
9 single numerical value.

10 Ding's motion has failed to set forth a prima facie case of entitlement to
11 relief. It is not necessary to consider Singer's opposition which construes its
12 claims in light of its own specification and attempts to show where the written
13 description lies for its claims 27 and 28.

14 Ding's Motion 1 is **denied**.

15 Ding's Motion 2

16 By Motion 2, party Ding asserts that both Singer's claims corresponding to
17 the count of this interference, claims 27 and 28, are unpatentable under 35 U.S.C. §
18 135(b)(2), which provides:

19 A claim which is the same as, or for the same or substantially the
20 same subject matter as, a claim of an application published under
21 section 122(b) of this title may be made in an application filed after
22 the application is published only if the claim is made before 1 year
23 after the date on which the application is published.
24

25 The application from which Ding's involved patent issued was published on
26 January 17, 2002, with claim 1, the same claim as claim 1 of Ding's involved
27 patent (BF. ¶ 12). Singer's involved application was filed on October 9, 2002, and

1 Singer's claims 27 and 28 were introduced into Singer's involved application by
2 amendment on September 21, 2004 (BF. ¶ 13).

3 According to party Ding, each of Singer's claim 27 and 28 is the same as, or
4 substantially the same as, claim 1 of Ding's published application. Singer does not
5 dispute that its claim 27 is the same as Ding's claim 1, but disagrees with party
6 Ding's assertion that Singer's claim 28 is substantially the same as Ding's claim 1.

7 More importantly, however, Singer asserts that whether any of its claims 27
8 and 28 is the same or substantially the same as Ding's claim 1 is irrelevant for
9 purposes of 35 U.S.C.

10 § 135(b)(2), because Singer's claims 27 and 28 were not "made in an application
11 filed after" publication of Ding's involved application, a triggering condition for
12 35 U.S.C. § 135(b)(2).

13 The key question is whether Singer's involved application is an application
14 filed after January 17, 2002, the date of publication of Ding's Published
15 Application US 2002/0006010. If it is, then a triggering or threshold condition of
16 35 U.S.C. § 135(b)(2) is met and we will need to consider the other parts of 35
17 U.S.C. § 135(b)(2) regarding whether Singer's claims 27 and 28 are for the same
18 or substantially the same subject matter as a claim in Ding's published application
19 and whether Singer's claims 27 and 28 were made before one year after the date of
20 publication of Ding's Published Application US 2002/0006010. If it is not, then
21 the inquiry is over and we need not proceed any further because 35 U.S.C. §
22 135(b)(2) has no application where the allegedly offending claims were not made
23 in an application filed after publication of the earlier application with a claim
24 drawn to the same or substantially the same subject matter.

25 The issue concerns 35 U.S.C. § 120, which in pertinent part states:

1 An application for patent for an invention disclosed in the
2 manner provided by the first paragraph of section 112 of this title in
3 an application previously filed in the United States, or as provided by
4 section 363 of this title, which is filed by an inventor or inventors
5 named in the previously filed application shall have the same effect,
6 as to such invention, as though filed on the date of the prior
7 application, if filed before the patenting or abandonment of or
8 termination of proceedings on the first application or on an application
9 similarly entitled tot he benefit of the filing date of the first
10 application and if it contains or is amended to contain a specific
11 reference to the earlier filed application.
12

13 Responding to Ding's motion, Singer identified two earlier filed applications
14 the respective filing dates of which Singer believes it is entitled under 35 U.S.C. §
15 120, for purposes of determining the effective filing date of its involved application
16 when applying 35 U.S.C.

17 § 135(b)(2): (1) a first application 09/262,781, filed on March 4, 1999 and issued
18 on November 6, 2001; and (2) a subsequent application 09/873,464, filed on June
19 4, 2001 and issued on May 6, 2003. Singer's involved application is a continuation
20 of application 09/873,464 ("the '464 parent application"), which is in turn a
21 continuation of application 09/262,781 ("the '781 grandparent application").

22 The inventive entity of the '464 parent application and of the '781
23 grandparent application is the same as that of Singer's involved application.
24 Singer's involved application contains a specific reference to the '464 parent
25 application, which contains a specific reference to the '781 grandparent
26 application. Singer's involved application was at one time copending with the
27 '464 parent application, which was at one time copending with the '781
28 grandparent application. Other than a specific reference to related patent
29 applications and the content of original claims filed together with the respective

1 applications, the disclosures of Singer's involved application, the '464 parent
2 application, and the '781 grandparent application are the same. None of these facts
3 is in dispute. Party Ding does not disagree with party Singer that the reference,
4 inventive entity, copendency, and disclosure requirements of 35 U.S.C. § 120 are
5 all met with respect to claims 27 and 28 of Singer's involved application in relation
6 to the '464 parent application and the '781 grandparent application.

7 What is in dispute is party Ding's assertion that the effective filing date
8 provision of 35 U.S.C. § 120 does not apply to determining the date Singer's
9 involved application was filed for purposes of applying 35 U.S.C. § 135(b)(2).

10 Ding argues (Motion at 1):

11 We submit that if Congress had intended that the language
12 "application filed after" appearing in 35 U.S.C. § 135(b)(2) be
13 governed by either (or both) 35 U.S.C. § 119(e) or 35 U.S.C. 120,
14 Congress would have made a specific reference to those sections in
15 the statute, as it had when it amended 35 U.S.C. 154 approximately
16 five years earlier. Congress did not, so 35 U.S.C. 135(b)(2) does not.

17
18 35 U.S.C. 154 sets the term of a patent to begin "on the date on
19 which the patent issues" and to end "20 years from the date on which
20 the application for patent was filed in the United States." The term
21 "filed" in 35 U.S.C. 154 is intended to refer (just as it does in 35
22 U.S.C. 135(b)(2)) to the actual -- not the effective -- filing date of the
23 application. The meaning for the term "filed" is made clear by the
24 subsequent phrase recited in section 154, i.e., "or, if the application
25 contains a specific reference to an earlier filed application, or
26 applications under section 120, 121, or 365(c) of this title, from the
27 date on which the earliest such application was filed." This
28 subsequent phrase would be completely redundant in the statute if the
29 earlier reference to the date on which the application was filed was
30 instead a reference to the effective filing date of the application.

31
32 We need not address 35 U.S.C. § 119. The language of 35 U.S.C. § 120 is

1 clear in specifying an “effective” filing date which may be earlier than an
2 application’s actual filing date, if certain conditions are met. No exception of any
3 kind is mentioned or provided, for any special scenario or circumstance. The later
4 application “shall have the same effect . . . as though filed on the date of the earlier
5 application.” Ding’s argument is rejected with regard to 35 U.S.C. § 120.

6 The fact that in recently amending 35 U.S.C. § 154, a statutory section
7 making reference to the date an application was filed in the United States,
8 Congress included additional language for applying 35 U.S.C. § 120 to make
9 significant and render effective an earlier filing date does not mean that Congress
10 necessarily had to make an express reference to 35 U.S.C. § 120 each time 35
11 U.S.C. § 120 would apply. Section 120, Title 35, United States Code, does not
12 require another statutory section to make an express reference to it before its
13 provision comes to life. There are many examples of applying the effective filing
14 date of 35 U.S.C. 120 without any specific reference to 35 U.S.C. § 120. See, for
15 instance, the date of filing of an application as referred to in 35 U.S.C. § 102(b), 35
16 U.S.C. § 102(d), and 35 U.S.C. § 102(e). Congress does not have to follow a fixed
17 format in drafting legislation; it may choose to use redundant language, or not.
18 Congress’ having made specific reference to 35 U.S.C. § 120 when amending 35
19 U.S.C. § 154 does not indicate that 35 U.S.C. § 120 has to be expressly invoked to
20 have application. That position is illogical and would mandate unnecessary
21 redundancy throughout the statute.

22 It is not our role to legislate. We need not consider the various advantages
23 and disadvantages articulated by the parties with regard to having 35 U.S.C. § 120
24 apply or not apply in the context of 35 U.S.C. § 135(b)(2). The statutory language
25 of 35 U.S.C. § 120 is clear and leaves no room for adding any scenario to which 35

1 U.S.C. § 120 does not apply. Since 35 U.S.C. § 135(b)(2) does not itself exclude
2 the application of 35 U.S.C. § 120, the latter does have application in the context of
3 the former.

4 For the foregoing reasons, we find that Singer's involved application is not
5 an application filed after the January 17, 2002 publication date of Ding's published
6 application US 2002/0006010. Singer's involved application has an effective
7 filing date of March 4, 1999. Therefore, Singer's claims 27 and 28 are not made in
8 an application that was filed after publication of Ding's published application. It is
9 not necessary to proceed any further with regard to consideration of Ding's motion.

10 Ding's Motion 2 is **denied**.

11 Singer's Motion 1

12 In Motion 1, Singer seeks to designate Ding's claims 2-13 and 15-17 as
13 corresponding to the count, and relies on the testimony of its technical witness, Dr.
14 George Barbastathis in connection with various factual assertions. Ding argues
15 that the testimony of Dr. Barbastathis should be given little or no weight because
16 (1) not one of Dr. Barbastathis' many publications discusses acoustic noise
17 management; (2) not one of Dr. Barabastathis' numerous publications is primarily
18 directed to acoustic noise management or mechanical stability; (3) Dr. Barbastathis
19 has had little, if any, practical experience with servo control of hard disk drives;
20 and (4) "Dr. Barbastathis has conducted zero research, invented zero inventions,
21 developed zero processes and designs, written zero articles, and taken part in zero
22 proceedings with respect to proximate time-optimal servomechanisms (PTOS), to
23 which the Ding patent is admittedly a modification" (Opp. page 3, lines 4-7).

24 The Federal Rules of Evidence applies in interference proceedings. 37 CFR
25 § 41.152(a). Fed. R. Evid. 702 states:

1 Rule 702. Testimony by Experts

2
3 If scientific, technical, or other specialized knowledge will assist the
4 trier of fact to understand the evidence or to determine a fact in issue,
5 a witness qualified as an expert by knowledge, skill, experience,
6 training, or education, may testify thereto in the form of an opinion or
7 otherwise, if (1) the testimony is based upon sufficient facts or data,
8 (2) the testimony is the product of reliable principles and methods,
9 and (3) the witness has applied the principles and methods reliably to
10 the facts of the case.
11

12 Ding's assertions, as noted above, even if assumed as true, are insufficient either to
13 disqualify Dr. Barbastathis as a technical expert, or to dismiss the testimony of Dr.
14 Barbastathis, categorically, as having little or no weight. Under Fed. R. Evid. 702,
15 reproduced above, the qualifications for providing expert testimony is broad and
16 flexible. They can be based on education, and not on experience. Or they can be
17 based on experience, and not on education. They can even be based on knowledge
18 not derived from either experience or formal education. There is also no
19 requirement that the "expert" must have conducted research on any subject, much
20 less a requirement that the "expert" must have made some invention on a subject or
21 a requirement that the "expert" must have published articles in professional
22 journals on anything.

23 For Dr. Barbastathis to give helpful testimony, it is not necessary that he
24 published any papers primarily concerning acoustic management or mechanical
25 stability, that he had practical working experience with servo control of hard disk
26 drives, that he conducted research, developed designs, or participated in projects
27 with respect to proximate time-optimal servomechanisms (PTOS). Ding's
28 approach to the issue is misplaced. Ding should have focused on the nature and

1 character of the experiences possessed by Dr. Barbastathis, the subject matter on
2 which Dr. Barbastathis has published papers, the inventions Dr. Barbastathis did
3 make, the designs which he did develop, and explain why such collection of
4 experiences, education, and achievements should be deemed so irrelevant to the
5 subject matter of this interference that the testimony of Dr. Barbastathis should be,
6 categorically, accorded little or no weight. That, however, was not done.
7 The key is adequate background to say something helpful on the topic, not actual
8 practical experience, invention, or research on the precise topic. Ding's argument
9 that the testimony of Dr. George Barbastathis should be, categorically, given little
10 or no weight is rejected.

11 During oral argument, the panel pointed out to Ding's counsel that even
12 Ding's own expert does not disagree with Dr. Barbastathis on the facts concerning
13 some Ding claims which Singer seeks to have designated as corresponding to the
14 count, and inquired as to what, in Ding's view, should happen in that situation.
15 Counsel for Ding replied (Transcript 51):

16 well, to the extent our expert doesn't disagree with theirs and the
17 board finds that their expert is deserving of some weight, then those
18 claims would have to be added to the count.
19

20 We find that the testimony of Dr. Barbastathis concerning technical facts is
21 entitled to some weight, based on his education, experience, and skills as outlined
22 in his curriculum vitae. Also, Ding has not, in its opposition and in connection
23 with its claims 2, 3, and 15-17, pointed to any testimony of its own technical
24 expert, Mr. William H. Ray, which contradicts those of Dr. Barbastathis in support
25 of designating Ding's claims 2, 3, and 15-17 as corresponding to the count.
26 Accordingly, with respect to Ding's claims 2, 3, and 15-17; Singer's Motion 1 is

1 **granted.**

2 With respect to Ding's claim 4, Singer's Motion 1 is **denied**, because the motion
3 lacks any discussion or analysis of why Ding's claim 4 should be designated as
4 corresponding to the count.

5 Singer argues that each of Ding's claims 11-13 should be designated as
6 corresponding to the count. Claim 11 depends from claim 1 and each of claims 12
7 and 13 depend from claim 11. Claims 1 and 11 read as follows:

8 1. A method of operating a disc drive for improved acoustic
9 management, comprising steps of:

10
11 (a) receiving an acoustic/performance compromising factor
12 from a host;

13
14 (b) tuning performance of a disc drive according to the
15 compromising factor, the step of tuning including applying the
16 compromising factor to at least one control parameter for the disk
17 drive to generate at least one modified control parameter; and

18
19 (c) executing a control loop for controlling an operation of the
20 disk drive, the control loop using the at least one modified control
21 parameter.

22
23 11. The method of claim 1, wherein the control loop includes a
24 velocity profile generator for generating a desired velocity based on a
25 difference between an actual and a target position, and the tuning step
26 (b) includes (b)(i) modifying the desired velocity.

27
28 At the outset, it is noted that Ding's claim 1 is not the same as Ding's claim
29 14 and that only Ding's claim 14 is an alternative of the count, not Ding's claim 1.
30 Singer's arguments in connection with this motion evidently presumes either that
31 Ding's claim 1 is an alternative in the count or that it reads the same as Ding's

1 claim 14 which is an alternative in the count. But neither is true. The failure to
2 account for the differences between Ding's claim 1 and Ding's claim 14 is alone
3 sufficient basis on which to deny Singer's motion, no matter how small Ding
4 believes the differences are. Accordingly, with respect to claims 11-13, the motion
5 is denied.

6 Alternatively, even if Singer's failure to account for the differences between
7 Ding's claim 1 and Ding's claim 14 is somehow ignored or overlooked, with
8 respect to claims 11-13 the motion still would be denied, for reasons discussed
9 below.

10 Singer first cites to 24 lines of the Pirzadeh patent (Patent 6,624,964) and the
11 states (Motion at 8-9):

12 The process 93 performed by the servo controller 56 generates a
13 desired normalized velocity signal $V_r + FC$ which is added to forward
14 feed value FC "to correct for any deviations" in velocity and position.
15 The resulting current value I_c is derated (i.e., a deration value is
16 applied to I_c) in a process 94. See Pirzadeh, Exhibit 1012, paragraph
17 bridging columns 7 and 8. See MF (40).

18
19 The above-quoted assertion of Singer is not reasonably understandable,
20 given Figure 5 of Pirzadeh and its corresponding disclosure. Singer's assertions
21 are incoherent and full of mistakes. First, in Pirzadeh's disclosure the normalized
22 velocity signal is V_r (Pirzadeh 7:16-17), not $V_r + FC$ according to the above-quoted
23 argument of Singer. And if we remove the incorrect reference to FC as a part of
24 the normalized velocity signal, the above-quoted assertions still incorrectly
25 identifies process 93 as generating the normalized velocity signal V_r . It is process
26 91 and not process 93 which generates V_r . (Pirzadeh 7:2-6, Figure 5).

1 And further if we were to ignore Pirzadeh's disclosure and thus regard the
2 sum of V_r and FC as the desired normalized velocity as Singer apparently asserts,
3 Singer nowhere points out what, then, in Pirzadeh qualifies as the "velocity profile
4 generator" required by claim 11. The velocity reference table 90 in Pirzadeh's
5 Figure 5 which takes as input the difference between an actual and a target
6 position, as is required by claim 11, cannot be the velocity profile generator
7 because the output from the table is not the sum of V_r and FC.

8 Even if V_r is regarded as the desired normalized signed velocity, the velocity
9 reference table 90 cannot be the claimed velocity profile generator because V_r is
10 not generated by the velocity reference table. Singer has failed to identify a
11 velocity profile generator in Pirzadeh that satisfies all the requirements of the
12 velocity profile generator of claim 11. Note that claim 14 as an alternative of the
13 count does not recite a velocity profile generator.

14 In any event, we read "modifying the desired velocity" such that it means a
15 new desired velocity is provided based on the modification. Ding is correct in
16 noting that Pirzadeh's velocity reference table 90 cannot be the claimed velocity
17 profile generator, because its output is immediately used to generate a ratio relative
18 to another variable. The ratio or quotient is no longer of the same nature and
19 character as the original desired velocity. The desired velocity is necessarily
20 unchanged in that scenario.

21 Because the differences between claim 11 and both the count and Pirzadeh
22 as applicable prior art have not been properly identified, and also because Singer's
23 characterization of Pirzadeh's disclosure is unpersuasive as discussed above, the
24 motion with respect to claims 11-13 is alternatively **denied** on those basis.

1 Singer argues that each of Ding's claims 5-10 should be designated as
2 corresponding to the count. The count in this interference is defined as Ding's
3 claim 14 or Singer's claim 28, in the alternative. Ding's claims 5-10 do not
4 depend from claim 14. Rather, claims 5, 7, and 9 each depend from claim 1; claim
5 8 depends from claim 7; and claim 10 depends from claim 9. Singer's motion
6 lacks any analysis directed to the differences between Ding's claim 1 and claim 14.
7 Those differences may not be ignored, since each dependent claim by operation of
8 law includes all the features of the claim on which it depends. 35 U.S.C. § 112, 4th
9 Paragraph. Singer has failed to consider the entirety of the differences between
10 claims 5-10 and the count. The fact that claim 1 was designated as corresponding
11 to the count at the outset of this interference does not mean all of its differences
12 from the count may be assumed to be non-existent when determining the
13 differences between each of claims 5-10 from the count. Singer may not divide
14 each claim into two parts and properly assert that if the first part by itself would
15 have been obvious and if the second part by itself would have been obvious then
16 the combination of the first and the second parts would have been obvious. The
17 entirety of the differences must be acknowledged in a single analysis.

18 Accordingly, with respect to Ding's claims 5-10, the motion is **denied**.

19 D. **Conclusion**

20 Ding's Motion 1 is **denied**.

21 Ding's Motion 2 is **denied**.

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1 Singer's Motion 1 is **granted-in-part**. The motion is granted with respect to
2 Ding's claims 2, 3, and 15-17. The motion is denied with respect to Ding's claim
3 4-13.

<u>/Jameson Lee/</u>)	
JAMESON LEE)	
Administrative Patent Judge)	
)	BOARD OF PATENT
)	
<u>/Sally C. Medley</u>)	APPEALS AND
SALLY C. MEDLEY)	
Administrative Patent Judge)	INTERFERENCES
)	
)	
<u>/James T. Moore/</u>)	
JAMES T. MOORE)	
Administrative Patent Judge)	

Interference No. 105,436

Ding v. Singer

By Electronic Transmission

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